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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/692,797	10/20/2000	Wenda Mason	23261/162	7141

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EXAMINER

PAK, JOHN D

ART UNIT	PAPER NUMBER
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1616

DATE MAILED: 12/03/2003

20

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/692,797

Applicant(s)

MASON, WENDA

Examiner

JOHN D PAK

Art Unit

1616

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 05 September 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-6, 11, 12 and 23-31 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☒ Claim(s) 1-6, 11 and 12 is/are allowed.
- 6) ☒ Claim(s) 23-31 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. §§ 119 and 120

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 13) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application) since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.
- a) ☐ The translation of the foreign language provisional application has been received.
- 14) ☒ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121 since a specific reference was included in the first sentence of the specification or in an Application Data Sheet. 37 CFR 1.78.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

Art Unit: 1616

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 9/5/03 has been entered.

Claims 1-6, 11-12 and 23-31 are pending in this application.

Applicant is advised that making the following changes will improve the claims and the specification:

Claim 12, line 4: after "1:1:2" but before the period, insert a comma and --- respectively --- .

The above amendment would ensure that the correct ratio components are attributed to the correct fatty acid/salts.

Subject to the above amendment, claims 1-6 and 11-12 are deemed allowable.

Claims 23 and 27 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 23 and 27 recite "10-undecanoic acid," but this appears to be incorrect nomenclature. The "10-" in chemical nomenclature usually means there is a substitution or unsaturation at the 10-position. If there is a substitution, the substituent

Art Unit: 1616

must be identified (e.g. 10-bromo-undecanoic acid), and if there is unsaturation, the type of unsaturation must be specified (e.g. 10-undecenoic acid).

If applicant amends to 10-undecenoic acid, applicant must provide descriptive support, or explanation thereof. While the skilled artisan would have recognized the presence of an error, it is applicant's burden to establish that the originally filed disclosure would have reasonably conveyed 10-undecenoic acid, i.e. there was sufficient written descriptive support for correcting to 10-undecenoic acid.

Applicant should note that the same nomenclature error is found on specification page 4, line 11, page 6, line 12, and the Abstract, line 11.

Claims 24-31 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

New claims 24-31 require a mixture of pelargonic acid + capric acid + caprylic acid, or salts thereof. The originally filed disclosure fails to provide sufficient written descriptive support for such a mixture. The closest_{ly} originally filed disclosure is found on specification page 4, lines 9-14:

The fatty acid component may be a fatty acid such as caprylic acid, pelargonic acid, capric acid, undecanoic acid, 10-undecanoic acid, lauric acid, oleic acid and mixtures of these fatty acids and other fatty acid mixtures such as soybean fatty acid and coconut fatty acid.

Art Unit: 1616

Similar disclosure is also found on page 5, first full paragraph, page 6, second paragraph, and original claim 3. On specification page 13, salt mixture of pelargonic + capric + lauric acid is specifically disclosed (see also page 5, second paragraph, last sentence). On specification page 5, mixture of capric + lauric acid is specifically disclosed (second paragraph, last two lines). Also on specification page 5, mixture contents of soybean fatty acids and coconut fatty acids are specifically disclosed. On specification page 6, mixtures of (i) pelargonic + capric, (ii) pelargonic + capric + coconut fatty acid, and (iii) soybean + coconut fatty acids are specifically disclosed.

In sum, while applicant originally disclosed many specific mixtures of fatty acids/salts, the specific mixture of pelargonic + capric + caprylic was not disclosed. Even though such a mixture is a theoretical possibility from the disclosures in original claim 3 and elsewhere (based on "mixtures thereof" language in claim 3 and similar language elsewhere), the originally filed disclosure fails to reasonably convey that the inventive mixture included pelargonic + capric + caprylic. Many specific mixtures were disclosed but not pelargonic + capric + caprylic. With seven fatty acids, "mixtures thereof" encompasses hundreds of various permutations involving two-, three-, four-, five-, and six-component mixtures. Without an explicit disclosure or some suggestion that would have led the skilled artisan to pelargonic + capric + caprylic, the Examiner must find that there was not sufficient written descriptive support for such subject matter.

For these reasons, claims 24-31 are rejected.

Art Unit: 1616

It is noted that there is no data for the subject matter covered by claims 24-31. The mixture of pelargonic + capric + caprylic has not been tested. It is so noted for the record. No data is required, as applicant is well aware.


The IDS citation of DE 0115622 has been crossed out. Review of parent application file contents did not turn up a copy of this reference. Additionally, a search in the Derwent file shows that there is no DE patent document for 115622. See attached search printout.

New references listed on the PTO-892 are cited to further show the state of the art.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to JOHN D PAK whose telephone number is (703)308-4538. The examiner can normally be reached on Monday to Friday from 8 AM to 4:30 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Thurman Page, can be reached on (703) 308-2927. The fax phone number for the organization where this application or proceeding is assigned is (703)308-4556.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703)308-1235.



JOHN PAK
PRIMARY EXAMINER
GROUP 1600